

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1-7 are currently pending in this application. No claims have been amended. Accordingly, no new matter has been added.

In view of the remarks herein, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

Issues Under 35 U.S.C. § 103(a)

The Examiner maintains the rejection of claims 1-7 under 35 U.S.C. §103(a) as obvious over Hosokawa (EP 0 889 063) (hereinafter Hosokawa '063) in view of Shimomura et al. (U.S. 4,959,060) (hereinafter Shimomura '060) "for the rationale recited in paragraph 6 of Office action dated on October 3, 2007". Applicants respectfully traverse.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Moreover, there must be a reason why one of ordinary skill in the art would modify the reference or combine reference teachings to obtain the invention. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the

"teaching, suggestion, motivation test" is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.*

Applicants respectfully submit that the Examiner's rejection appears to be based on a misunderstanding of the prior art of record. For instance, at pages 3-4 of the outstanding Office Action, the Examiner asserts that Shimomura '060 teaches the step of "drying the wet absorbent polymer" in the several examples of the method (Examples 3-5), for the purpose of incorporating compound (A) in the body fluid-absorbent member. This assertion, however, is incorrect.

Shimomura '060 discloses, as part of the description of method (3) (see column 4, lines 51-59) for the incorporation of compound (A): "the compound (A) to be contained in layers in the absorbent member by spraying a solution or dispersion of the compound (A) on the absorbent polymer then drying the wet absorbent polymer". According to Example 1 of Shimomura '060, an aqueous 20 % sodium thiosulfate solution (reducing agent) is added to an absorbent polymer (Trademark: "AQUALIC CA") which has already been dried as a product.

The Examiner appears to misunderstand that at no point does Shimomura '060 teach or suggest adding the reducing agent to a polymer when the polymer is in a water-containing gelated state, as presently claimed. The following sequences do not give equivalent final products:

Shimomura et al.:

Dry absorbent polymer + aqueous reducing agent → wet product → drying → final product

Present Invention:

Water-containing gelated absorbent polymer + reducing agent/oxidizing agent → Water containing gelated product → drying → final product

Clearly, Shimomura '060 does not teach or suggest adding the reducing agent to a polymer when the polymer is in a water-containing gelated state, as presently claimed. As shown in the attached Figure, the compound (A) is added to the absorbent polymer **once dried** (emphasis added). This greatly differs from the method of the present invention. Other examples of Shimomura '060 disclose commercially available absorbent polymers treated in a similar manner. Shimomura '060 does not in any way teach or suggest that, after polymerization of acrylic acid or its salt, the compound (A) is added to a gelated product **prior to or during drying** (emphasis added). Accordingly, Shimomura '060 cannot possibly render the present invention, requiring that a reducing agent or an oxidizing agent is added to a gelated product after polymerization but prior to or during drying, obvious.

Clearly, the prior art of record, alone or in combination, fails to teach or suggest each and every limitation of the present invention. For this reason alone, this rejection is improper and should be withdrawn.

Additionally, Applicants submit that the unexpected and superior results obtained by the present invention rebut any *prima facie* case of obviousness allegedly established by the Examiner.

In the Response filed on February 4, 2008, Applicants submitted a Declaration under 37 CFR 1.132 showing that the yellow index after production of the products of the prior art is

extremely high, so that coloration resistance is unacceptable, whereas coloration resistance is superior in the method of the present invention.

At page 6 of the outstanding Office Action, the Examiner discusses the results of experiments performed by Applicants and appears to assume the position that the experiments conducted by Applicants are not sufficient to establish that the final product of Hosokawa '063 and Shimomura '060 would not inherently exhibit the same characteristics as the final product of the present invention. It seems that the Examiner may be requiring that comparative tests be conducted not against something actually disclosed in the prior art but against a modified version of the prior art.

Applicants respectfully disagree with the Examiner's position and submit that the Examiner's position is not proper. *See In re Fenn*, 639 F.2d 762, 765, 208 USPQ 470 (CCPA 1981), *In re Merchant*, 575 F.2d 865, 869, 197 USPQ 785, 788 (CCPA 1978) and *In re DeBlauwe*, 222 USPQ 191 (Fed. Cir. 1984)). Under U.S. patent laws, it is sufficient to compare a claimed invention with the closest prior art and show that the differences in properties are unexpected. It is not necessary to compare a claimed invention with a "modified" version of the prior art.

Thus, Applicants submit that the results of the Declaration Under 37 C.F.R. filed on February 4, 2008 are sufficient evidence that the present invention achieves unexpected and superior results over the closest prior art. Accordingly, Applicants submit that the present rejection is improper and should be withdrawn.

Because the invention, as set forth in Applicants' claims, is not disclosed or made obvious by the cited prior art, reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion


All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Gerald M. Murphy, Jr., Reg. No. 28,977 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.147; particularly, extension of time fees.

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Respectfully submitted,

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